

REMARKS

Any fees that may be due in connection with the filing of this paper or with this application may be charged to Deposit Account No. 06-1050. If a Petition for Extension of time is needed, this paper is to be considered such Petition.

TRAVERSAL OF RESTRICTION REQUIREMENT

Claims 1-54, 58-60, 63-76, 86, 88-124 and 127-144 are presently pending and are subject to a Restriction Requirement. The Office Action sets forth two (2) groups for election:

- I: Claims 1-54, 58-60, 63-76, 88-123 and 128, directed to methods for sequencing a target nucleic acid; and
- II: Claims 86, 124, 127 and 129-144, directed to an array of nucleic acid probes.

Applicant traverses the requirement for restriction on the following basis.

As set forth in MPEP § 803(I), there are two criteria for proper requirement for restriction between claims to patentably distinct subject matter:

- (A) The inventions must be independent or distinct as claimed; **and**
- (B) There would be a serious burden on the examiner if restriction is not required.
[emphasis added].

The Examiner alleges that Group II and group I are related as a product and method of using the product. As between subject matter that is related in this manner, restriction is proper if the method may be practiced with another materially different product or the if the product may be used in a materially different method. Applicant respectfully submits that, in addition, for restriction to be proper, there must be a serious burden on the Office to examine the claims in the same application:

[i]f the search and examination of an entire application can be made without serious burden the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions [see MPEP 803].

With respect to groups I and II, it is herein urged that there is no serious burden on the Office to examine the claims in groups I and II in a single application. It is noted that this application is an RCE of an application that has been ongoing since 1999 and has had several Office Actions, including three final actions and two Requests for Continued Examination. Claims directed to methods for sequencing a target nucleic acid and arrays of nucleic acid probes have been present in the application since initially filed and previously have been searched and examined. Hence, there is no serious burden on the Office to continue

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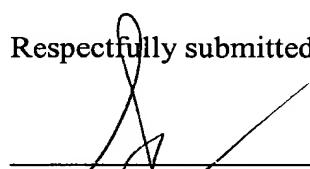
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Provisional Election & Response

examining the claims in the same application. Reconsideration and withdrawal of the restriction requirement as between groups I and II is, therefore, respectfully requested.

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In view of the provisional election and remarks herein, examination on the merits is respectfully requested.

Respectfully submitted,


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